



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,769	07/28/2006	Sami Saribas	019957-016830US	2116
20350 7590 11/26/2007 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER MEAH, MOHAMMAD Y	
			ART UNIT 1652	PAPER NUMBER
			MAIL DATE 11/26/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/587,769	Applicant(s) SARIBAS ET AL.	
	Examiner Mohammad Meah	Art Unit 1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/25/07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-33 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The claims 1-33 are pending in the instant office action.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1. In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1. claims 1-11 drawn to method of refolding glycosyltransferase wherein glycosyltransferase is GnT1

Group 2. claims 1-11 drawn to method of refolding glycosyltransferase wherein glycosyltransferase is GalT1

Group 3. claims 1-14 drawn to method of refolding glycosyltransferase wherein glycosyltransferase is St3 GalIII

Group 4. claims 1-14 drawn to method of refolding glycosyltransferase wherein glycosyltransferase is St3GalI

Group 5. claims 1-14 drawn to method of refolding glycosyltransferase wherein glycosyltransferase is St6 GalNAcT1.

Group 6. claims 1-11 drawn to method of refolding glycosyltransferase wherein glycosyltransferase is Core Gal1T1T1

Group 7. claims 1-11 drawn to method of refolding glycosyltransferase wherein glycosyltransferase is GalNAcT2

Group 8. claims 15-21 drawn, recombinant glycosyltransferase wherein glycosyltransferase is GnT1

Group 9. claims 15-18, 22-24, drawn recombinant glycosyltransferase wherein glycosyltransferase is GalT1

Group 10. claims 15-18, 25, 26, drawn recombinant glycosyltransferase wherein glycosyltransferase is St3 GalIII

Group 11. claims 15-18, 28, 29, drawn recombinant glycosyltransferase wherein glycosyltransferase is St3GalII

Art Unit: 1652

Group 12. claims 15-18, 30, drawn recombinant glycosyltransferase wherein glycosyltransferase is St6 GalNAcT1.

Group 13. claims 15-18, 27, drawn to recombinant glycosyltransferase wherein glycosyltransferase is Core Gal1TI

Group 14. claims 15-18, 31, 32 drawn to recombinant glycosyltransferase wherein glycosyltransferase is GalNAcT2

Group 15. claim 33, drawn to method of remodeling glycosyltransferase wherein glycosyltransferase is GnT1

Group 16. claim 33, drawn to method of remodeling glycosyltransferase wherein glycosyltransferase is GalT1

Group 17. claim 33, drawn to method of remodeling glycosyltransferase wherein glycosyltransferase is StIII Gal3

Group 18. claim 33, drawn to method of remodeling glycosyltransferase wherein glycosyltransferase is St3GalI

Art Unit: 1652

Group 19. claims 33 drawn to method of remodeling glycosyltransferase wherein glycosyltransferase is St6 GalNAcT1.

Group 20. claim 33, drawn to method of remodeling glycosyltransferase wherein glycosyltransferase is Core Gal1T1T1

Group 21. claim 33, drawn to method of remodeling glycosyltransferase wherein glycosyltransferase is GalNAcT2

The inventions listed in Groups 1-21 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The technical features of Groups 8-14 are products (glycosyltransferases , proteins). The protein of group 8 has distinct structure, function and properties that are not shared by protein of group 9 and so on . Therefore groups 8- 14 proteins do not share same technical features. The special technical features of Groups 1-7 and Groups 15-21 are different method steps resulting different outcomes , accordingly groups 1-7 are not so linked by the same or corresponding special technical feature to that of groups 15-21 as to form a single general inventive concept. Groups 15-21 and 8-14 share a technical feature, a product (glycoproteins). Group 15-21 claims use the product of group 8-14 in their method steps. However said

Art Unit: 1652

products can be used in different method steps having different technical features, such as to make carbohydrate.

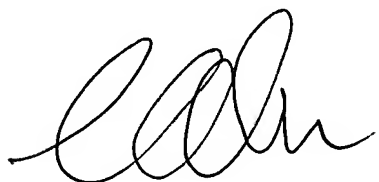
Furthermore; technical feature linking groups 1-21 appears to be that they all related to glycosyltransferase comprising maltose binding domain. The glycosyltransferase comprising maltose binding domain does not constitute a "special technical feature" as defined by PCT Rule 13.2, because it does not claim a feature which defines a contribution over the prior art as glycosyltransferase comprising maltose binding domain is taught by Bayer et al. (US 60/377,730, May 3, 2002).In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143). Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Art Unit: 1652

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad Meah whose telephone number is 571-272-1261. The examiner can normally be reached on 8:30-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapu Achutamurthy can be reached on 571-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Mohammad Meah', with a stylized, cursive script.

Mohammad Younus Meah, PhD

Examiner, Art Unit 1652

Recombinant Enzymes, 3C31 Remsen Bld

400 Dulany Street, Alexandria, VA 22314

Telephone: 517-272-1261